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OFFICE OF PETITIONS

In re Application of	:	
Tsukada, et al.	:	
Application No. 10/724,706	:	DECISION ON PETITION
Filed: 2 December, 2003	:	
Attorney Docket No. 1982-0208P	:	

This is a decision on the petition filed under 37 C.F.R. §1.78(a)(3), on 8 January, 2007, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application (Application No. 09/953,958 filed 18 September, 2001) set forth by amendment filed with the petition. It is noted, however, that the petition and the amendment submitted also seeks a late claim to priority to a foreign-filed application, which claim properly is made under 37 C.F.R. §1.55(c) to Japan Application No. P2000-281809, filed on 18 September, 2000 (in addition to the previously claimed priority to Japan Application No. P2002-351466, filed on 3 December, 2002 (as set forth in the originally filed oath/declaration and the supplemental Application Data Sheet)). The petition herein is so construed.

The petition is **DISMISSED**.

PETITION UNDER 37 C.F.R. §1.78(a)(3)

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. §120 and 37 C.F.R. §1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in §1.17(t); and

- (3) a statement that the entire delay between the date the claim was due under 37 C.F.R. §1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition is deficient in items (1) and (3), which are discussed below since the petition under 37 C.F.R. §1.55(c) is deficient for similar issues.

PETITION UNDER 37 C.F.R. §1.55(c)

A petition under 37 C.F.R. §1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date and be included either in an oath or declaration (37 C.F.R. §1.63(c)(2)) or in an Application Data Sheet (37 C.F.R. §1.76(b)(6));
- (3) the surcharge as set forth in 37 C.F.R. §1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 C.F.R. §1.55(a)(1) and the date the claim was filed was unintentional (the Director may require additional information where there is a question whether the delay was unintentional); and
- (5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

This application was filed on 2 December, 2003, which is after November 29, 2000 and within 12 months of 2 December, 2002 (the filing date of the foreign application to which benefit is now being claimed). On 8 January, 2007, an Application Data Sheet was submitted, apparently in lieu of executed oath/declaration (37 C.F.R. § 1.55(d)(1)(ii)), which identifies the foreign application for which priority is claimed by application number, country and filing date. The required petition fee authorization was received with the petition.

This petition is deficient in items (2) and (4).

DISCUSSION

The regulations at 37 CFR § 1.55(c) and §1.78(c) require a statement that the entire delay between the date the claim was due under 37 CFR § 1.55(a)(1) and §1.78 and the date the claim was filed was unintentional. Since the statement appearing in the petition varies from the required language, on renewed petition (if submitted) Petitioner should track the language of the regulation.

The petition fails to comply with the requirement for a signed oath/declaration or a signed supplemental ADS. In this regard, a review of the file record fails to disclose that the priority information was included in an oath or declaration or in an Application Data Sheet (ADS) in accordance with 37 C.F.R. §1.76(b)(6). Unless provided in an ADS, 37 CFR §1.63(c)(2) requires that the oath or declaration must identify the foreign application for patent (or inventor's certificate) for which priority is claimed under 37 C.F.R. §1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing. *Note* MPEP §201.14.

In view of the above, compliance with 37 C.F.R. §1.63(c)(2) or 37 C.F.R. §1.76(b)(6) must be satisfied if applicant desires to claim priority to the foreign application noted in the petition. Any future petition should include a cover letter and be entitled "Renewed Petition under 37 C.F.R. §1.55(c)."

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

Any inquiries concerning this decision may be directed to John Gillon, Attorney, at (571) 272-3214. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

A handwritten signature in black ink, appearing to read 'Anthony Knight', with a stylized flourish extending from the end.

Anthony Knight
Supervisor
Office of Petitions